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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,678	03/25/2004	Jeremy Green	VPI/02-137 US	6199

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VERTEX PHARMACEUTICALS INC.
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EXAMINER

OWENS, AMELIA A

ART UNIT	PAPER NUMBER
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1625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/808,678

Applicant(s)

GREEN ET AL.

Examiner

Amelia A. Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47,49-54,56 and 59-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50 and 51 is/are allowed.
- 6) ☒ Claim(s) 47,49,52-54,56,59-64,100 and 101 is/are rejected.
- 7) ☒ Claim(s) 65-99 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☒ Other: NO DRAWINGS.

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DETAILED ACTION

1. Claims 1-46,48,55,57,58 have been canceled. Claims 47,49-54,56,59-101 are pending.

Election/Restrictions

2. Applicant's election without traverse of Group V, Claims ~~47-58~~, ^{47, 49-54, 56} (newly added 59-101) in the reply filed on November 6, 2006 is acknowledged.

Applicants elected species I-12.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 52-54,56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In cases involving unpredictable factors, e.g., physical activity, the scope of enablement provided by the specification to one skilled in the art varies inversely with the degree of unpredictability of the factors involved. Cancer treatment is known by the artisan to be highly unpredictable as underscored by Gura (Science, v278, 1997, pp. 1041-1 042) who discusses the potential shortcomings of potential anti-cancer agents including extrapolating from in-vitro to in-vivo protocols, the problems of drug testing in knockout mice, and problems associated with clonogenic assays. Indeed, since formal screening began in 1955, thousands of drugs have shown activity in either cell or animal models, but only 39 that are used exclusively for chemotherapy, as opposed to supportive care, have won approval from the FDA (page 1041, 1st column)

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wherein the fundamental problem in drug discovery for cancer is that the model systems are not predictive. Cancer treatment is known to be compound and disease specific, that is a particular compound or class of compound can be useful in treating a particular type or class of cancer.

The specification at page 23 line 17 teaches 'treatment' encompasses prevention, prevent, preventing, etc. Reasonable guidance with respect to preventing any cancer relies on quantitative analysis from defined populations that have been successfully pre-screened and are predisposed to particular types of cancer. This type of data might be derived from widespread genetic analysis, cancer clusters, or family histories. The essential element towards the validation of a preventive therapeutic is the ability to test the drug on subjects monitored in advance of clinical cancer and link those results with subsequent histological confirmation of the presence or absence of disease. This irrefutable link between antecedent drug and subsequent knowledge of the prevention of the disease is the essence of a valid preventive agent. Further, a preventive administration also must assume that the therapeutic will be safe and tolerable for anyone susceptible to the disease. All of this underscores the criticality of providing workable examples which are not disclosed in the specification, particularly in an unpredictable art such as cancer therapy.

Applicants point out representative compounds according to the invention have been tested via NCI 60-cell line anticancer assay. The compounds tested are not commensurate in scope with the protection sought. Further, those of skill in the art recognize that in vitro assays and or cell-cultured based assays are generally useful to observe basic physiological and cellular phenomenon such as screening effects of potential drugs. However, clinical correlations are generally lacking. The issue of "correlation" is related to the issue of the presence or absence of working examples. "Correlation" as used herein refers to the relationship between in vitro or in vivo animal model assays and the disclosed/claimed method of use. An in vitro or in vivo animal model example in the specification, in effect, constitutes a "working example" if that example "correlates" with a disclosed or claimed method invention. The instant application contains no such animal model or example, therefore there is no correlation and the examples do not constitute "working examples."

Further, the greatly increased complexity of the in vivo environment as compared to the very narrowly defined and controlled conditions of an in- vitro assay does not permit a single

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extrapolation of in vitro assays to human diagnostic efficacy with any reasonable degree of predictability. In vitro assays cannot easily assess cell-cell interactions that may be important in a particular pathological state. Furthermore it is well known in the art that cultured cells, over a period time, lose phenotypic characteristics associated with their normal counterpart cell type. Freshney (Culture of Animal Cells, A Manual of Basic Technique, Alan R. Liss, Inc., 1983, New York, p4) teach that it is recognized in the art that there are many differences between cultured cells and their counterparts in vivo. These differences stem from the dissociation of cells from a three-dimensional geometry and their propagation on a two-dimensional substrate. Specific cell interactions characteristic of histology of the tissue are lost. The culture environment lacks the input of the nervous and endocrine systems involved in homeostatic regulation in vivo. Without this control, cellular metabolism may be more constant in vitro but may not be truly representative of the tissue from which the cells were derived. This has often led to tissue culture being regarded in a rather skeptical light (p. 4, see Major Differences In Vitro). Further, Dermer (Bio/Technology, 1994, 12:320) teaches that, "petri-dish cancer" is a poor representation of malignancy, with characteristics profoundly different from the human disease. Dermer teaches that when a normal or malignant body cell adapts to immortal life in culture, it takes an evolutionary type step that enables the new line to thrive in its artificial environment. This step transforms a cell from one that is stable and differentiated to one that is not. Yet normal or malignant cells in vitro are not like that. The reference states that evidence of the contradictions between life on the bottom of a lab dish and in the body has been in the scientific literature for more than 30 years. Clearly it is well known in the art that cells in culture exhibit characteristics different from those in vivo and cannot duplicate the complex conditions of the in vivo environment involved in host-tumor and cell-cell interactions.

Doses required to practice their invention are described@ page 24. There are no guidelines for determining the doses needed to provide a breast cancer effect vs. a CNS *system* effect vs. a renal *system* effect. Are the identical doses to be used for treating these unrelated forms of cancer?

The artisan using Applicants invention would be a physician with a MD degree and several years of experience. Again, it is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved", and physiological activity

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is generally considered to be an unpredictable factor. See *In re Fisher*, 166 USPQ 18, at 24 (In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.), *Nationwide Chemical Corporation, et al. v. Wright, et al.*, 192 USPQ 95 (one skilled in chemical and biological arts cannot always reasonably predict how different chemical compounds and elements might behave under varying circumstances), *Ex parte Sudilovsky* 21 USPQ2d 1702 (Appellant's invention concerns pharmaceutical activity. Because there is no evidence of record of analogous activity for similar compounds, the art is relatively unpredictable) *In re Wright* 27 USPQ2d 1510 (the physiological activity of RNA viruses was sufficiently unpredictable that success in developing specific avian recombinant virus vaccine was uncertain). h) The scope of the claims involves all of the thousands of compounds of the claims as well as the hundred of diseases embraced by the term cancer. Thus, the scope of claims is very broad.

MPEP §2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." Based upon the relevant evidence as a whole, there is no reasonable correlation between the disclosed in vitro utility and an in vivo activity. In view of the teachings above, and the lack of guidance and or exemplification in the specification, it would not be predictable that the method would function as contemplated. Thus, it would require undue experimentation by one of skill in the art to practice the invention as claimed.

Claims 49,53,56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The issue concerning the meaning of terms chemotherapeutic or anti-proliferative agent or anti-inflammatory agent, an immunomodulatory or immunosuppressive agent, a

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neutropic factor, treating immunodeficiency disorders; certain leukemias or lymphomas. How is the artisan to determine which leukemias or lymphomas without guidance.

According to the MPEP §2163 I. A. "the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art." The MPEP states in §2163 II 3 ii) "The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice (see i)(A), above), reduction to drawings (see i)(B), above), or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus (see i)(C), above). See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406." Applicants have disclosed no species.

The Court of Appeals for the Federal Circuit held in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 at 1406. "[a] written description of an invention involving a chemical genus, like a description of a chemical species, "requires a precise definition, such as by structure, formula, [or] chemical name, "of the claimed subject matter sufficient to distinguish it from other materials. *In re Smythe*, 480 F.2d 1376, 1383, *Fiers*, 984 F.2d at 1171, 25 USPQ2d at 1606; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284-85 (CCPA 1973) ("In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus. . . .")." Applicants' functional definitions in the claimed formula simply lack the precision required by the Court of Appeals for the Federal Circuit.

According to the MPEP §2163.02 Standard for Determining Compliance With the Written Description Requirement,

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"The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed". *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter". *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983))."

Thus, the skilled artisan, who would use Applicants' compounds, would not know what is meant by the terms. That skilled artisan would not have understood the inventor to be in possession of the claimed invention at the time of filing.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 47, 49,50,53,59-64,100,101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 47,50 - for example define R1 as $(L)_mR$ where R is C1-C6 alkyl and m is zero. It is unclear how this works when R is C2-C6 alkyl.

Claims 49,53 employ the term agent, which is ambiguous.

Claims 59-64,100 have a variable $(ZR^X)_X$, yet the claim does not define the subscript X. Nor is definition found in generic claim 47.

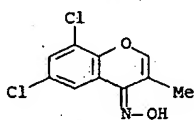
Claim 101 when listing the compounds does not have commas, nor does it have a proper Markush ending.

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Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Moon et al USP 4065574 that teach species according to the invention. See column 4 lines 25-26. The compounds are fungicides. See column 11 lines 5-33; 42-56.

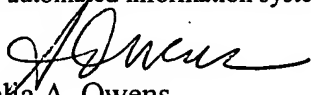


Claims 65-99 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Amelia A. Owens
Primary Examiner
Art Unit 1625